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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1131-0505PUS1															
		Application Number 10/803,959-Conf. #6483	Filed March 19, 2004														
		First Named Inventor Yoshikazu KITAJIMA															
		Art Unit 2833	Examiner T. X. M. Chung														
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/></td><td>applicant /inventor.</td><td rowspan="2"> Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent of record. Registration number _____</td><td>Charles Gorenstein Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>29,271</u></td><td>(703) 205-8000 Telephone number</td></tr><tr><td></td><td></td><td>November 28, 2005 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>				<input type="checkbox"/>	applicant /inventor.	 Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<input type="checkbox"/>	attorney or agent of record. Registration number _____	Charles Gorenstein Typed or printed name	<input checked="" type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>29,271</u>	(703) 205-8000 Telephone number			November 28, 2005 Date
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<input type="checkbox"/>	attorney or agent of record. Registration number _____	Charles Gorenstein Typed or printed name															
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		November 28, 2005 Date															



BOX AF
REPLY UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2833

PATENT
1131-0505P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	Y. Kitajima	Conf.: 6483
Appl. No.:	10/803,959	Group: 2833
Filed:	March 19, 2004	Examiner: Chung Trans
For:	TAB TERMINAL	

STATEMENT ACCOMPANYING PRE-APPEAL BRIEF
REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 28, 2005

Sir:

Introductory Comments

Applicant requests review of the Final Rejection in the above-identified application. An Amendment was filed on October 25, 2005. In an Advisory Action the Examiner stated that the Amendment would be entered upon filing an Appeal. In fact, the Examiner did address one of the added features of amended Claim 7 in the last sentence of page 2 of the Advisory Action. Thus, the argument set forth below will be directed to the claims presented on October 25, 2005.

This request of three (3) pages is being filed concurrently with a Notice of Appeal.

Discussion of Rejections

Claims 1-8 and 10 were rejected under 35 USC 103(a) as being unpatentable over Clark (USP 4,332,430) in view of Kobayashi (USP 4,907,991). The rejection clearly fails to show a *prima facie* case of obviousness as the parts are not shown or there is no motivation to combine the elements from the references. Claims 3-8 are pending.

There are at least two features in base claim 7 that are not shown or suggested by the references. The first feature is as follows:

“said first and second contact portions extend at an angle slightly smaller than right angles with respect to said first and second sidewall portions, respectively”
[see Figure 4, element 1f]

The second feature in Claim 7 recites the following:

“The first and second contact portions extend in a direction towards each other; and wherein said first and second contact portions are adapted to be connected with the printed circuit board” [element 1e, Figures 1, 4 and 5]

There is no question that Clark, the base reference, shows a terminal which is not bent and Kobayashi shows the end portions in parallel but extending outwardly from each other. See, for example, Figure 1 of Kobayashi. Thus these two references fail to show or suggest the features in claim 7.

The object of the structure is to provide a tab terminal electrically and surely connectable to both the electro-connection part and the printed circuit board in spite of its small size and simple shape.

With respect to the features in Claim 7, and specifically with respect to the first noted portion of Claim 7 referenced above regarding “the angle,” the Examiner in the Advisory Action stated that this would have been obvious to one skilled in the art. Truly, this is speculation which is unsupported by any evidence. Furthermore, this structure provides a result (e.g., secure soldering)

that must be considered in arriving at any conclusion of obviousness. See The Gillette Co. v. S.C. Johnson & Son, Inc. 16 USPQ2d 1923, 1928 (Fed. Cir. 1990) wherein the Court stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). [Cited in the MPEP.]

With respect to the second feature noted above as to Claim 7, the first and second contact portions extend in a direction toward each other, so that the first and second contact portions are not protruding outside the terminal body, which enables miniaturization of the tab terminal. Consequently, the tab terminal makes it possible to improve the efficiencies of mounting of electrical parts onto the printed circuit board. It is noted that this feature was in Claim 9 (now canceled) in the Reply of May 13, 2005. As stated above, the features of “extending in towards each other” is now in Claim 7 (amended).

In the Office Action of July 26, 2005, the Examiner cited Guyette (U.S. Patent No. 4,037,898) in the rejection of Claim 9 which is now contained in Claim 7 (amended). It was the Examiner’s position that the first and second contact portions (tabs 13) extend in a direction toward each other. First of all, these contact portions are not soldered to the printed circuit board. In fact, when they are inserted through the hole, they extend outwardly from each other as shown in Figure 10. Thus, the reference to Guyette would not support the second feature of Claim 7 as explained above.

With respect to dependent Claim 5, this claim has a pickup portion to which a pickup of a monitor is accessible. With this feature, placement of the terminal is expedited. This feature was not addressed in the “Final” Office Action.

With respect to the dependent claims not discussed above, these claims are considered patentable at least for the same reason as the base Claim 7.

It appears that the Examiner asserts that one of ordinary skill in the art could make the claimed invention. But capability is not a test of obviousness. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), cited in the MPEP in Section 2143.01, pages 2100-131.

It is requested that the claims pending be allowed.


Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
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Date: November 28, 2005


CG/EAG//kmr
1131-0505P

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